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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,469	01/18/2006	Thilo Dollase	101769-310-WCG	3249
27386 7590 11/14/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,469

Applicant(s)

DOLLASE ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 9/17/2008 have been entered. Claim 6 has been amended. New claims 12-15 are entered. Claims 1, 2, 4-6 and 8-15 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 1, 2, 8, 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-025460 [machine translation], and evidenced by applicants' admission.

JP '460 relates to an acrylic pressure-sensitive adhesive composition. The composition comprises block copolymer represented by the formula (A-B)_a-A, wherein A is a vinyl (co)polymer, B is a (co)polymer of a 1-12C alkyl (meth)acrylate, and a = 1 to 10. For example, an A-B-A block copolymer obtained by copolymerizing n-butyl acrylate polymer blocks with

methyl methacrylate block [abstract]. The adhesive can be used to form a pressure sensitive adhesive sheet, etc., on one side or both sides of a base material, such as paper, etc. [0058 and 0060].

For claims 1, 2 and 8, JP '460 is silent about the glass transition temperatures and immiscibility of the polymer blocks. However, since applicants have admitted that useful monomers of block P(A) include acrylic esters with alkyl groups having 4 to 14 carbon atoms (e.g., n-butyl acrylate), etc. [specification, page 15], and useful monomers of block P(B) include methyl methacrylate, etc. [specification, page 16], and further admitted that the amounts of monomers and their ratios, etc., are result effective [Remarks page 8], workable glass transition temperatures and miscibility of the A-B-A block copolymer (n-butyl acrylate polymer blocks and methyl methacrylate polymer block) taught by JP '460 are deemed to be either anticipated, or obviously provided by practicing the invention of prior art for same end uses as pressure sensitive adhesives for various applications.

For claim 9, since the block copolymers are either anticipated, or obviously provided by practicing the invention of prior art as set forth above, their refractive indices are deemed to be inherent properties of the same chemistry.

For claim 11, selecting a commercially acceptable color for the paper support of an adhesive sheet product is also deemed to be either anticipated, or obviously provided by practicing the prior art for the same end uses.

5. Claims 4, 5, 6, 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-025460 [machine translation], and evidenced by applicants' admission.

The teachings of prior art are again relied upon as set forth above.

For claims 4, 5 and 10, JP '460 is silent about the use of release layer and adhesion promoting primer layer. However, absence of any errors, the Official notice in the prior Office action "these layers are common and well known" is now taken as admitted prior art. It would have been obvious to one of ordinary skill in the art to incorporate that layers in adhesive sheets formed from the adhesives of JP '460, motivated by the desire to improve the release property of individual adhesive sheets from a multilayered adhesive pad; and to enhance the adhesion between the adhesive layer and support, respectively.

For claims 6 and 12-15, the prior art is silent about providing the pressure sensitive adhesive sheet in the form of a pad of plurality of adhesive sheets. However, the examiner takes Official notice that providing a plurality of adhesive sheets in the form of a pad of conveniently predetermined size is common and well known.

Response to Arguments

6. Applicants argue at Remarks page 8 that

"it is well-known that the fact that two polymers are made from the same types of monomers or comonomers does not mean that the polymers will possess the same properties. Differences in amounts of respective monomers, ratios of monomers, positions of the monomers within the polymer, and polymerization method, among other things, all establish the resultant properties of the respective polymers. Identical properties cannot be presumed unless all result-effective variables are identical and the Examiner has not here established that this is the case."

However, since applicants have admitted that the amounts of monomers and their ratios, etc., are result effective [Remarks page 8], workable glass transition temperatures and miscibility of the A-B-A block copolymer (n-butyl acrylate polymer blocks and methyl methacrylate polymer block) taught by JP '460 are deemed to be either anticipated, or obviously provided by practicing

the invention of prior art for same end uses as pressure sensitive adhesives for various applications.

In response to the amendment, the ground of rejection for claim 6 has been updated as set forth above. Applicants' arguments at pages 9-10 directed to withdrawn reasoning are moot.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794